

REMARKS

Applicants acknowledge receipt of an Office Action dated December 3, 2003. In this response Applicants have amended claim 26 to incorporate the subject matter of dependent claims 29 and 30. Specifically, claim 26 has been amended to recite, "wherein the hard carbon-based film has a coefficient of friction of not higher than 0.07 and wherein the hard carbon-based film has a surface roughness, Ra, of not higher than 0.1 μm ". Claims 33 and 37 have also been amended to recite, "wherein the hard carbon-based film has a coefficient of friction of not higher than 0.07 and wherein the hard carbon-based film has a surface roughness, Ra, of not higher than 0.1 μm ." Claims 29 and 30 have been canceled without prejudice or disclaimer as they are now redundant.

Claims 39-46 have been withdrawn from consideration by the PTO as being drawn to non-elected subject matter. Applicants note that claims 39-46 ultimately depend from claim 33. Inasmuch as claim 33 is now believed to be *prima facie* allowable, Applicants respectfully request that the PTO consider and rejoin claims 39-46.

Following entry of these amendments, claims 26-28, 31-38 and 47-49 are pending and under consideration in the application.

Reconsideration of the present application is respectfully requested in view of the foregoing amendments and the remarks which follow.

Summary of Telephonic Interview Conducted on March 4, 2004

Applicants' representative, Mr. Paul D. Strain, wishes to thank Examiner Turner for the courtesies extended to Mr. Strain during a telephonic interview conducted on March 4, 2004. During the interview, Mr. Strain and Examiner Turner discussed the outstanding rejections under §112, 1st paragraph.

IDS Filed September 12, 2003

Applicants acknowledge receipt of signed, dated and initialed copies of pages 1 and 2 (of 3) of the form PTO/SB/08 submitted with the IDS filed on September 12, 2003.

Applicants understand that the PTO has copies of all of the references cited on page 3 (of 3) of that IDS, and that only a copy of page 3 of the form PTO/SB/08 is absent in the PTO file. With this response, Applicants have included a copy of page 3 (of 3) of the form PTO/SB/08 from the IDS filed on September 12, 2003. Applicants respectfully request that the PTO return a signed, dated and initialed copy of the enclosed form PTO/SB/08 with its next communication.

IDS Filed August 14, 2000

To date, Applicants have not received a signed, dated and initialed form PTO-1449 from the IDS filed on August 14, 2000. With this response, Applicants have provided a copy of the form PTO-1449 submitted with the IDS filed on August 14, 2000. Applicants respectfully request that the PTO return a signed, dated and initialed copy of the enclosed form PTO -1449.

Allowed Claims

Applicants gratefully acknowledge the PTO's indication, on page 3 of the Office Action, that claims 48 and 49 have been allowed.

Rejections Under 35 U.S.C. § 112

On page 2 of the Office Action, the PTO has rejected claims 26-28, 30-38 and 47 under 35 U.S.C. § 112, first paragraph, as, allegedly, being based upon on a disclosure which is not enabling. In addition, the PTO has rejected claims 26-29, 31-38 and 47 under 35 U.S.C. § 112, first paragraph, as, allegedly, being based on a disclosure which is not enabling. Applicants respectfully submit that the facts of the present case are distinguishable from those in the *Mayhew* case relied upon by the PTO, and that there is insufficient evidence to support the PTO's mere allegation that the recited elements constitute "critical or essential" elements of Applicants' invention.

Applicants therefore respectfully traverse these rejections; however, in view of the nature of the complex technical issues raised in the Office Action and discussed at the interview, it is possible that Applicants may have to undertake further investigation and/or

prepare data or other evidence to properly and completely resolve the issues. Thus, in order to expedite the grant of patent rights based on the subject matter acknowledged as patentable in this application, Applicants have chosen to remove these issues *in the present application* and have consequently amended independent claims 26, 33 and 47 to recite “wherein the hard carbon-based film has a coefficient of friction of not higher than 0.07 and wherein the hard carbon-based film has a surface roughness, Ra, of not higher than 0.1 μm ”. Applicants submit that these amendments obviate and moot the outstanding rejections under 35 U.S.C. §112, 1st paragraph and place claims 26-47 in *prima facie* allowable form.

Applicants expressly reserve the right to pursue claims directed to the broader subject matter, including claims which do not recite “wherein the hard carbon-based film has a coefficient of friction of not higher than 0.07 and wherein the hard carbon-based film has a surface roughness, Ra, of not higher than 0.1 μm ,” in one or more continuing and/or divisional applications. In other words, Applicants’ action in amending certain claims in the present application is *not* an acquiescence to the grounds of rejection set forth in the outstanding Office Action. As noted above, Applicants believe the rejections to be inappropriate.

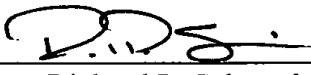
In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections under §112, 1st paragraph.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that all of the pending claims are now in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, the Examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

Date 6/3/04
FOLEY & LARDNER
Customer Number: 22428
Telephone: (202) 672-5540
Facsimile: (202) 672-5399

By 
Richard L. Schwaab
Attorney for Applicants
Registration No. 25,479

Paul D. Strain
Agent for Applicants
Registration No. 47,369

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.